

REMARKS

It is noted that the previous Amendment by Applicant overcame portions of the reference Hirose, but that a new prior art document (Holehan) is now being cited where Hirose was determined to be lacking in disclosure.

Claim rejections under 35 U.S.C. § 103

In item 3, claims 8, 9, 12-17, 22, 23, 26-31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose (5,170,348), Holehan (5,988,902) in view of Gerpheide (6,473,069) and further in view of Godfrey et al. (5,433,610).

The Office Action has added the reference of Holehan in order to provide a "single-sensing surface" and an "overlay" as originally taught or amended into the claims.

Applicant respectfully traverses the rejection of claims 8, 22 and 36 in light of the newly added reference of Holehan by the following analysis. This analysis is directed to the elements as listed in claim 8, but applies to claims 22 and 36 as well.

The combination of references now being cited fail to teach two critical and claimed aspects of the present invention. Specifically, the invention must be a finger-operated hand-held device that includes all the keys of a standard keyboard. It is this combination that the references cannot justify because individually, they teach away from this combination. If any of these references teach away from a concept that is critical to justify picking elements needed to create the present invention, then the combination fails

and they do not make the present invention obvious.

The whole focus of Applicant's argument is that it has been the conclusion of the prior art devices, including all the prior art references cited by the Examiner, that it is NOT possible to have all the keys of a standard keyboard disposed within the area of a typical touchpad, and still be finger operated.

Looking at Hirose first, Hirose teaches away from the present invention because it is strictly a "touch pen" or stylus operated device (see col. 1, lines 33 through 38). Hirose teaches that the "character inputting switches" are actuated exclusively by the touch pen. Possible finger operation of the character inputting switches cannot be implied. Thus, it does not matter if any of the other references teach a finger-operated device. None of those references teach very small areas for keys! Hirose is the only reference provided that teaches a device that has the quantity of keys similar to a standard keyboard, and it teaches away from the concept of being a finger-operated device.

Looking at Holehan, it very distinctly teaches full size keys. Holehan was trying to provide a touchpad to replace just a small number of keys that were being displaced because of the small keyboard area of a laptop. Holehan did not try and teach putting the whole standard keyboard on the touchpad because, and this is important, Holehan says that the big problem is that "[a]ll else being equal, laptop computer operators would prefer to have a full size keyboard" (col. 1, lines 57-58). Very clearly, Holehan has taught away from the present invention because it does not want to shrink the size of the keys that it displays on its overlays. Holehan wants full size keys, but simply arranged so

that they are not in a staggered arrangement. Thus, while Holehan clearly teaches a finger-operated device, the keys are not smaller than full size keys. Holehan does not teach that a finger can operate keys that are smaller than full size keys. Hirose also fails to teach that a finger can operate keys that are smaller than full size keys. It is noted that Gerpheide also fails to teach that a finger can operate keys that are smaller than full size keys.

For arguments sake, it is noted that there are devices that include keys that are arranged in a small area. However, these keys are typically discrete mechanical switches, and not touchpads. Accordingly, Applicant respectfully asserts that the prior art fails to make the invention obvious.

It is also noted again that the touchpad technology of the present invention was first sold in a commercially available product in 1994. The first patent for this technology (US Patent No. 5,305,017) issued to Cirque Corporation, the assignee of the present application, was not issued until 1994. Therefore, this technology should not have been known to Hirose at the time Hirose was filed in 1991.

It is asserted that Hirose also teaches the fifth element of the claims, wherein the fifth element is *"an audio feedback system that causes a pre-recorded sound to be made audible whenever any key of the plurality of keys is touched on the touchpad keyboard."*

Applicant respectfully traverses the assertion that the combination of Godfrey and Hirose makes obvious the element of audible feedback. The purpose and function of audible feedback is of importance when considering method claims 8 and 22. The

purpose of the audible feedback in the present invention is only to provide assurance to a user that a particular key on an overlay has been touched. This is necessary because of the small area available for the keys of a standard keyboard.

The purpose of the audible feedback in Godfrey is different. The purpose in Godfrey is to give a relatively long message that teaches a user about the picture that has been touched. The purposes are not the same, and therefore the obviousness of the action cannot be imputed to the claims of the present invention. Furthermore, it is asserted that Godfrey does not make the apparatus claim 36 any more obvious because Hirose is so substantially deficient in its teachings that it should not be used to reject the claims of the present application.

Regarding claims 9 and 23, it is asserted that the combination of Hirose, Gerpheide and Godfrey make obvious the audible feedback. Applicant respectfully traverses because the function of the pre-recorded voice in Godfrey is not to provide feedback that a button has in fact been touched as in the present invention, but only to play a pre-recorded message that teaches the user about the object in the picture that has been touched. When the functions are so clearly and greatly different, the function cannot be imputed to the method as taught by the present application. The user of Godfrey desires to play a message that will teach the user. The desire is to obtain an audible message. In contrast, the purpose of the user is not to obtain audible feedback. The desire of the user is only to know if a key has been selected so that the user knows that data has been entered.

Regarding claims 12 and 26, it is asserted that Hirose teaches a communication cable coupled to a communication port.

Applicant respectfully asserts that for the reasons given above that explain why Hirose, Holehan and Gerpheide do not teach or suggest the present invention, that claims 12 and 26 are therefore dependent upon allowable base claims.

Regarding claims 13 and 27, it is asserted that Hirose teaches that the hand-held and portable electronic appliance is a portable computer.

Applicant respectfully asserts that for the reasons given above that explain why Hirose, Holehan and Gerpheide do not teach or suggest the present invention, that claims 13 and 27 are therefore dependent upon allowable base claims.

Regarding claims 14 and 28, it is asserted that Hirose teaches that the communications port is wire.

Applicant respectfully asserts that a wire is only one of the methods given for communication between a portable electronic appliance and a touchpad keyboard. Hirose does not teach or suggest the other methods. Furthermore, for the reasons given above that explain why Hirose, Holehan and Gerpheide do not teach or suggest the present invention, it is asserted that claims 14 and 27 are therefore dependent upon allowable base claims.

Regarding claims 15 and 29, it is asserted that the combination of Hirose, Holehan, Gerpheide and Godfrey teaches a touchpad keyboard that includes an overlay further comprises tactile feedback.

For the reasons given above that explain why Hirose, Holehan and Gerpheide do not teach or suggest the present invention, it is asserted that claims 15 and 29 are therefore dependent upon allowable base claims.

Regarding claims 16 and 30, it is asserted that the combination of Hirose, Gerpheide and Godfrey teaches a touchpad keyboard that includes a plurality of raised ridges defining a plurality of zones.

For the reasons given above that explain why Hirose, Holehan and Gerpheide do not teach or suggest the present invention, it is asserted that claims 16 and 30 are therefore dependent upon allowable base claims.

Regarding claims 17 and 31, it is asserted that Hirose teaches that the touchpad is capacitance-sensitive, electrostatic, finger or stylus responsive devices.

Applicant respectfully traverses the rejection of these claims. A device can include the above-cited technologies without being a touchpad keyboard as defined by the present invention. As Hirose fails to teach a touchpad as defined by the present invention as explained previously in support of claims 8, 22, and 26, there is no reason to impute such a teaching to Hirose, especially when a touchpad as defined by the present invention was not sold commercially until three years after the filing of Hirose.

In item 4, claims 10 and 24 are rejected as being unpatentable over Hirose, Holehan, Gerpheide, Godfrey and further in view of Kikinis. It is asserted that the first four references fail to teach a mechanical wheel for scrolling of data.

For the reasons given above that explain why Hirose, Holehan and Gerpheide do

not teach or suggest the present invention, it is asserted that claims 10 and 24 are therefore dependent upon allowable base claims.

In item 5, claims 11, 21, 25 and 35 are rejected as being unpatentable over Hirose, Holehan, Gerpheide, Godfrey and further in view of Kono. It is asserted that the first three references fail to teach a scrolling zone, but that Kono teaches a scrolling zone.

Applicant respectfully traverses the rejection of these claims. Kono does not teach a scrolling zone where a user slides an object up and down to cause scrolling. Kono specifically teaches two buttons, one for scrolling up and one for scrolling down. A scroll zone is not the same thing as individual buttons that a user touches to actuate. Kono does not require sliding of a finger, and in fact would not operate as the does the present application if the user slid the finger from one button to the other.

Regarding claim 37, it is asserted the Kono teaches the aspect of a microphone for recording audio data for transmission via a network, and for live transmission via a network.

Applicant respectfully traverses the rejection of these claims. None of the references cited teaches anything about a computer network. Teaching a microphone in Kono cannot be used to also assert that the audio data is being recorded for transmission via a compute network, or for live transmission via a computer network, when no computer network is even suggested by any of the references.

In item 6, claims 18, 19, 32 and 33 are rejected as being unpatentable over Hirose, Holehan, Gerpheide, Godfrey and further in view of Grant et al. It is asserted

that Grant teaches a dedicated key for web navigation and for actuating a computer program.

For the reasons given above that explain why Hirose, Holehan and Gerpheide do not teach or suggest the present invention, it is asserted that claims 18, 19, 32 and 33 are therefore dependent upon allowable base claims.

In item 7, claims 20 and 34 are rejected as being unpatentable over Hirose, Holehan, Gerpheide, Godfrey and further in view of Ure. It is asserted that Ure teaches a mode switch that enables switching functions between a touchpad keyboard and a cursor control device.

Applicant respectfully traverses the rejection of the claims. For the reasons given above that explain why Hirose, Holehan and Gerpheide do not teach or suggest the present invention, it is asserted that claims 20 and 34 are therefore dependent upon allowable base claims.

Conclusion

In light of the statements above, Applicant respectfully requests issuance of claims 8 to 37. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the examiner is invited to call David W. O'Bryant at (801) 478-0071 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0881.

DATED this 9th day of December, 2005.

Respectfully submitted,

A handwritten signature in black ink, reading "David W. O'Bryant". The signature is fluid and cursive, with the first name "David" being the most prominent.

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